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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/777,539	02/11/2004	Ibnsina Karkenny	KARKEN-44629	5136
26252	7590	09/11/2006		
KELLY LOWRY & KELLEY, LLP 6320 CANOGA AVENUE SUITE 1650 WOODLAND HILLS, CA 91367			EXAMINER LANG, AMY T	
			ART UNIT	PAPER NUMBER
			1714	

DATE MAILED: 09/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/777,539

Applicant(s)

KARKENNY, IBNSINA

Examiner

Amy T. Lang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 19-26 is/are allowed.
- 6) ☒ Claim(s) 1-4, 10 and 11 is/are rejected.
- 7) ☒ Claim(s) 4, 11 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>2-11-2004</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Claim Objections

1. Claim 4 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 1, from which claim 4 is dependent only discloses a process to make oil. However, claim 4 discloses an additional process of making a paste. Since claim 4 does not further define the oil making process, but instead includes an additional process that is not within the scope of claim 1, it does not further limit the subject matter in claim 1.
2. Claim 11 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 10, from which claim 11 is dependent only discloses a process to make a paste. However, claim 11 discloses an additional process of making oil. Since claim 11 does not further define the paste making process, but instead includes an additional process that is not within the scope of claim 10, it does not further limit the subject matter in claim 10.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 4 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 4 recites the limitation "dividing the egg yolk in to a first portion to make a lubrication paste." However, the claim fails to disclose the process in which the lubrication paste is made. Therefore, it is the examiner's position that this claim fails to distinctly claim the applicant's invention.

5. Claim 11 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 11 recites the limitation "dividing the egg yolk in to a first portion to make the paste and a second portion to make an oil." However, the claim fails to disclose the process in which the oil is made. Therefore, it is the examiner's position that this claim fails to distinctly claim the applicant's invention.

Claim Rejections - 35 USC § 103

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

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7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Herring (US 4,219,585) in view of Hatanaka (US 5,028,449).

Herring discloses a process to form oil derived from an egg yolk (column 1, lines 5-7). The process involves first separating the yolk from the white albumen and then placing the yolks in a cooking vessel (column 2, lines 36-42). The cooking vessel is then placed over a heat source so that yolks reach a temperature between 375 to 400 degrees Fahrenheit (190.56 to 204.44 degrees Celsius) (column 2, lines 40-51). Water is removed by evaporation during this step, which clearly overlaps claim 3 (column 2, lines 46-47). The oil is then produced, which intrinsically functions as a lubricant additive, since oil is suitable for a lubricant additive.

Herring does not disclose the cooking vessel as a closed vessel.

Hatanaka also discloses a process to form oil derived from egg yolk (column 1, lines 8-12). This process also involves separating the egg yolk from the white albumen and then placing the yolk into a suitable cooking vessel (column 2, lines 61-68). Hatanaka further discloses that the cooking vessel is advantageously a closed vessel (column 2, line 68 through column 3, line 4). Therefore, since Herring does not

specifically disclose the vessel as open or closed and Hatanaka discloses that closed cooking vessels are advantageous for heating an egg yolk to make oil, it would have been obvious for Herring to also utilize a closed vessel.

9. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Herring (US 4,219,585) in view of Hatanaka (US 5,028,449) and Hawley's Condensed Chemical Dictionary.

Herring discloses a process that forms an oil and paste derived from an egg yolk (column 1, lines 5-7). This process involves first separating the egg yolk from the white albumen (column 2, lines 36-39). The egg yolk is then heated in a cooking vessel within the range of 375 to 400 degrees Fahrenheit (190.56 to 204.44 degrees Celsius) (column 2, lines 40-51). During the heating process the yolks are constantly mashed and stirred so that a dry content of yolks have become charred (column 2, lines 47-56). This dry content is equivalent to the brown paste in the instant claim.

Herring does not disclose (i) the brown charred paste as a lubricant additive and (ii) the cooking vessel as an open heating vessel.

With respect to (i) above, although Herring does not specifically disclose the charred paste as a lubricant additive, given that a paste is "a soft, viscous mass" (Hawley's, pp 841) it is therefore the examiner's position that the paste would have lubricity to some extent and thereby intrinsically function as a lubricant additive.

With respect to (ii) above, Hatanaka also discloses a process to form a charred paste from an egg yolk (column 3, lines 27-28). This process also involves separating

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the egg yolk from the white albumen and then placing the yolk into a suitable cooking vessel (column 2, lines 61-68). Hatanaka further discloses that the cooking vessel is either a closed or open heating vessel (column 2, line 68 through column 3, line 4).

Therefore, since Herring does not specifically disclose the vessel as open or closed and Hatanaka discloses that either an open or closed heating vessel may be used, it would have been obvious for Herring to utilize an open vessel.

Allowable Subject Matter

10. Claims 19-26 are allowed. The prior art references do not teach the combination of a paste additive and oil additive for a lubricating composition.

11. Claims 5-9 and 12-18 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amy T. Lang whose telephone number is 571-272-9057. The examiner can normally be reached on M-F 8:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

ATL
8/24/06

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